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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,151	01/15/2002	Robert C. Lehr	100201014-1	8861

22879 7590 06/24/2010

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
3404 E. Harmony Road
Mail Stop 35
FORT COLLINS, CO 80528

EXAMINER

FISHER, MICHAEL J

ART UNIT	PAPER NUMBER
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3689

NOTIFICATION DATE	DELIVERY MODE
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06/24/2010

ELECTRONIC

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ipa.mail@hp.com
laura.m.clark@hp.com



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/045,151
Filing Date: January 15, 2002
Appellant(s): LEHR ET AL.

John K. Harrop (reg #41,817)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/12/10 appealing from the Office action
mailed 12/10/09.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
1-16, 18-61.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

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subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,745,884

Carnegie et al.

4-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,8-12,16,18-25,27,28,32,35,37-41,44,45,,47,48 and 50-54 are rejected under 35 U.S.C. 102(b) as being anticipated by US PAT 5,745,884 to Carnegie et al. (Carnegie).

As to claims 1,18,19, 27,37,45, Carnegie discloses a hardware pay per use system (title) comprising one or more hardware products (col 4, lines 53-56), a metering

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agent that acquires metric data (306,316, as best seen in fig 3), and a usage repository that generates reports on the received data (308, 318).

As to claim 20, as the user is charged for usage, the "data to report" would be usage (metrics data" and the "usage report" (bill) would be based on this.

As to claim 53, the device would be at the central server and therefore would not be at the device, a processor controls the operation (fig 1).

As to claims 2,39, the system generates and sends bills (308,318).

As to claims 3,21,40,50,51, the usage reports are visible and available to the client as they are included in the bills, the invoice is presented (bill), payment is expected and therefore, it would be inherent that it can be received.

As to claims 4,48, Carnegie discloses a validation server (fig 3, it validates the data in that it checks to see who should be billed), a usage database (where the account info is and to which is added billing data, 308,318), it would inherently ensure that the hardware is correctly configured else it could not use the network.

As to claim 8,28,44,52 the hardware devices collect the metric data that is also acquired by the metering device (claim 5), it would inherently use software to do so.

As to claims 9,22,39, there are rules to be used to determine the data (fig 3).

As to claims 10,38, the system polls the hardware to determine to acquire metrics data (to check if the user has an account).

As to claims 11,41, the data is provided on a periodic basis (claim 7).

As to claims 12, a CPU is used (fig 1).

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As to claims 16,35, the metering mechanism and usage repository are not at the same site as the device.

As to claims 22, the usage reports are based on applying rules (fig 3).

As to claims 23, it would be inherent that the usage reports are compared to pricing schemes as the pricing schemes affect the billing.

As to claims 24, it would be inherent that the rate is affected by the plan.

As to claims 25, as the rules are used by a business, they would inherently be "business" rules.

As to claims 32,48, the operating data is verified (to ensure that the user has an account), verifying an approved configuration (fig 3) that would inherently be saved, saving the operating data (316).

As to claim 47, as the hardware is connected to the Internet, it would inherently be on a "digital site".

As to claim 54, Carnegie discloses encrypted, compressed data (219,222, as best seen in fig 2).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5-7, 13-15,26, 29-31,33,34,36,42,43,46,49 and 55-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carnegie.

As to claims 5-7, the actual make-up of the various components would not make the invention patentably distinct as these are all well-known computer variations and it would be obvious to use them as Carnegie uses computers.

As to claim 13, Carnegie does not, however, teach leasing the equipment. However, it is old and well known in the art to lease equipment. Therefore, it would have been obvious to one of ordinary skill in the art to lease the equipment to ensure that your customers could have the necessary equipment with a minimum of investment on their part.

As to claims 14,33, the location of the devices would not make the invention patentably distinct as they are merely a matter of obvious design choice.

As to claims 15,34,36, Carnegie discloses using the Internet (fig 1), therefore, it would have been obvious to one of ordinary skill in the art to use the Internet to ease retrieval of information.

As to claim 26, it would be obvious to report a peak utilization to better study the program to ensure its smooth operation.

As to claim 29, it would be obvious to bill the entity leasing the hardware as they are responsible for it.

As to claim 30, the lessee would enquire about getting service with the company.

As to claim 31, the usage reports are visible and available to the client as they are included in the bills, the invoice is presented (bill), payment is expected and therefore, it would be inherent that it can be received.

As to claim 42, the periodic rate would be considered a matter of obvious design choice and would not make the invention patentably distinct.

As to claim 43, it would be obvious to check the configuration is the same so as to ensure that it is the correct user using the system and not a so-called "hacker".

As to claim 46, where the products are installed is considered to be a matter of obvious design choice and would not make the invention patentably distinct.

As to claim 49, Carnegie does not specifically teach that the acquiring means is a stand-alone computer. This would be a matter of obvious design choice, as it is merely another variation on the computer taught by Carnegie, and would not make the invention patentably distinct.

As to claim 55, it would have been obvious to test transport means to ensure that the customer is billed properly.

As to claim 56, the system uses email (col 9, lines 1-6).

As to claim 57, it would be obvious to test the device to ensure that it has not received a virus.

As to claim 58, the known response would prove that the user has an account (fig 3).

As to claim 59, it would have been obvious to one of ordinary skill in the art to use the metering engine to check the known response as the metering agent is used in setting charges.

As to claim 60, the device uses the Internet (fig 1).

As to claim 61, the Internet is a digital, data, communications network.

(10) Response to Argument

As to arguments in relation to the independent claims, there is no language in the claims that precludes a “per connection” reading, indeed, the title of the application and the preamble to independent claims 1,18,19,20,37,45 and 53 specifically call the instant invention a “Hardware pay per use”. Further, Carnegie most certainly does charge a user based on an operation of the computer, the operation when it connects to their network. The metrics of Carnegie most certainly do “relate” to the “operation of the computer”, i.e. when it is using their network. That is ‘related’ to the computer (as it involves the computer) and ‘operational’ (the operation being ‘connecting to the network’).

As the examiner has repeatedly noted throughout prosecution, the claims as written are extremely broad and it is incumbent on the examiner to give them their broadest possible interpretation. As to arguments that “...nowhere in Carnegie's disclosure is billing based on connection ever disclosed or suggested.”, appellant is directed to the title of Carnegie (“System and Method for Billing Data Grade Network Use On A Per Connection Basis”), and further to the first line of the abstract (“A system and method in which remote users may be billed on a per connection basis”). As to arguments that fig 3 does not describe a “metering agent that acquires metric data”, appellant is directed (as repeatedly and previously noted during prosecution) to block 306. The metric, as previously and repeatedly noted in both rejections and responses to arguments, is the “per connection”. The term “metric” is far more broad than appellant appears to realize. As to arguments that Carnegie does not contain one “scintilla” of

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disclosure to suggest any other basis for billing, the examiner agrees. Carnegie bills based on the "operation" of the computer in connecting to their network. This absolutely meets the limitations as claimed, as repeatedly and previously discussed. Appellant has never explained why the examiner is wrong on this point, merely argued that examiner is wrong, such as at the top of page 14 of the instant brief, this is not proper argument.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Fisher

/Michael J Fisher/

Examiner, Art Unit 3689

Conferees:

Janice Mooneyham

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689

Vincent Millin/vm/

Appeals Conference Specialist